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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/100,671

06/19/1998

JEFFREY MARK ZUCKER

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35690

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07/29/2008

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EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/100,671	Applicant(s) ZUCKER ET AL.	
	Examiner Yehdega Retta	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 87-92 and 148-159 is/are pending in the application.
- 4a) Of the above claim(s) 93-132 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 87-92 and 148-159 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to Election/Restriction filed March 06, 2008. Applicant amended claims 88-93, 96, 97, 99, 100, 103, 105, 108-111, 116, 121, 122 canceled claims 133-147 and added new claims 148-159.

Election/Restrictions

Applicant's election with traverse of group I(claims 87-92) in the reply filed on May 6, 2008 is acknowledged. The traversal is on the ground(s) that an apparatus and a process cannot be separate subcombinations of the same combination and on the ground that it is not clear that separate searches need to be performed (since the classification is the same). This is not found persuasive because According to MPEP "(i)n applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a restriction requirement. See MPEP § 806.05(c) (combination and subcombination) and § 806.05(j) (related products or related processes) for examples of when a two-way test is required for distinctness. Related inventions in the same statutory class are considered mutually exclusive, or not overlapping in scope, if a first invention would not infringe a second invention, and the second invention would not infringe the first invention 806.05(a)". In Combination and Subcombination, a combination is an organization of which a subcombination or element is a part. 806.05(c) and to support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a serious search burden if restriction were not required as evidenced by separate classification, status, or field of search. See MPEP § 808.02. The inventions are distinct if it can

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be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination. Even though the inventions are classified in the same subclass it does not mean the separate inventions do not require a separate search.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 87, 88, 90-92, 148-150, 152-156, 158 and 159 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gabber et al. U.S. Patent No. 5,961,593.

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Regarding claims 87, 88, 90-92, 148-150, 152-156, 158 and 159, Gabber teaches a financial institution maintaining an actual credit account for a first entity; the financial institution establishing a pseudo credit account corresponding to the actual credit account, identifier for the pseudo credit account, pseudo expiration data; pseudo identity, the financial institution receiving the pseudo credit account identifier from a second entity through an electronic network (see col. 8 lines 18-62, col. 10 lines 22-65, col. 11 line 54 to col. 13 line 53). Gabber teaches transmitting payment from the financial institution to the second user on behalf of the first user under the pseudo credit account identifier. Gabber teaches the proxy system provides substitute identifiers that include the feature of anonymity, keeping the identity of the user secret that is the server sites (second user) cannot determine the true identity of the first user (see col. 8 lines 35-44). Gabber also teaches the substitute identifiers transmitted to the server site (on behalf of the first user) (see col. 10 lines 41-65). Gabber further teaches the central proxy system includes functionality necessary to support electronic payment, the users employ electronic payment information to engage in anonymous commerce with the server sites, further the substitute identifiers may be constructed at least in part using credit/debit card number. Since in Gabber the substitute identifiers are transmitted to the second user from the proxy system to engage in anonymous communication between the user and the server sites, it is clear that the substitute identification created using the credit information is also sent to the second user from the proxy system on behalf of the first user during commerce transaction (see col. 12 lines 45-56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 89, 151 and 157 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber further in view Official Notice.

Regarding claims 89, 151 and 157, Gabber does not explicitly teach configuring the pseudo credit account identifier so that it can be used only once. Official notice is taken that is well known in the art of e-commerce to have a credit account that can be used only once. Financial institutions allow account for single transaction or limited transaction or for specific use or transaction. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to create a pseudo account as in Gabber for the single use credit card in order to allow a single use credit account in Gabber's system to minimize fraud or misuse of credit cards.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622